UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,291	02/28/2002	Shiyan S. Hua	LUT 20079	3105

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EXAMINER
WOO, ISAAC M

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/087,291	HUA ET AL.
	Examiner	Art Unit	
	Isaac M. Woo	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>19 September 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Pre-Appeal Conference Request

1.   In view of the Pre-Appeal conference request filed on 19 September 2005,

PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2.   Claims 1-20 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the

Invention

The claimed invention as a whole must accomplish a practical

application. That is, it must produce a "useful, concrete and tangible

result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of

this requirement is to limit patent protection to inventions that possess a

certain level of "real world" value, as opposed to subject matter that

represents nothing more than an idea or concept, or is simply a starting

point for future investigation or research (Brenner v. Manson, 383 U.S. 519,

528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26

USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure

should contain some indication of the practical application for the claimed

invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under

the patent eligibility standard requires significant functionality to be

present to satisfy the useful result aspect of the practical application

requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely

claiming nonfunctional descriptive material stored in a computer-readable

medium does not make the invention eligible for patenting. For example, a

claim directed to a word processing file stored on a disk may satisfy the

utility requirement of 35 U.S.C. 101 since the information stored may have

some "real world" value. However, the mere fact that the claim may satisfy

the utility requirement of 35 U.S.C. 101 does not mean that a useful result

is achieved under the practical application requirement. The claimed

invention as a whole must produce a "useful, concrete and tangible" result to

have a practical application.

Regarding claim 1, "A method of searching television programming information"

can be implemented without computer or machine. Because the limitation of claim 1,

"receiving", "generating", "searching", and "sending" can be implemented by a human

with a pencil, and a piece of paper for searching an electronic document. Thus, the

languages of claim 1 raises a question as to whether the claimed method is directed

merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible

result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore,

the claimed invention is non-statutory subject matter. The claims should be amended to

indicate that the subject matter is implemented by a computer, i.e., a computer

implemented method.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Junqua et al (U.S. Patent No. 6,314,398, hereinafter, "Junqua") in view of Kaizu et al

(U.S. Pub 2004/0015989, hereinafter, "Kaizu").

    With respect to claim 1, Junqua discloses, searching a database in accordance

with the search query (col. 3, lines 18-44, col. 6, lines 26-26-29), the database

containing television programming information (54, program database, fig. 1, col. 3,

lines 18-44, EPG is stored on program database); generating search results from the

searching (col. 4, lines 14-22), the search results including entries from the database

that correspond to the search query; and, sending the search results to a television

receiver box (52, set-top decoder box, fig. 1, col. 4, lines 14-22) of the viewer via a

television system (50, TV, fig. 1) such that the search results are displayable upon a

television operatively connected to the receiver box (46, 50, fig. 1, results are displayed

on TV screen, col. 3, lines 7-67 to col. 4, lines 1-55). Junqua does not explicitly

disclose, receiving a telephone call from a viewer via a telephone system, generating a

search query in response to the telephone call. However, Kaizu discloses, "In step

S204, the main control unit 61 judges whether the user has made a voice input through

the microphone 43. The step is repeated until a voice input is judged to be made.

[0301] If in step S204 the user is judged to have made a voice input (e.g., pronouncing

"registered user"), step S205 is reached. In step S205, the main control unit 61 boots

the voice recognition program 173 to recognize the voice entered in step S204. From

step S205, control is returned to step S202If in step S204 the user is judged to have

made a voice input (e.g., pronouncing "registered user"), step S205 is reached. In step

S205, the main control unit 61 boots the voice recognition program 173 to recognize

the voice entered in step S204. From step S205, control is returned to step S202", see

(page 17, sections [0300-0301]), [0302] In step S202, the main control unit 61 receives

another compact HTML file from the EPG server 10 via the Internet 8, and displays a

predetermined screen (log-in screen of FIG. 16 in this case) reflecting the received file

on the liquid crystal display 35. At the same time, the sound corresponding to the

content of the file is fed to the speaker 34 for output. This causes the speaker 34 to

output an audio message, such as "Please pronounce your user ID and password",

and "If in step S203 the user is judged to have requested transmission of the recording

reservation data, step S206 is reached. In step S206, the main control unit 61

disconnects from the EPG server 10. [0307] Given the transmission request, the EPG

server 10 searches the EPG information database (not shown) for the recording

reservation data needed to reserve the desired TV program of a specific TV station,

retrieves the applicable recording reservation data", see (page 17, sections [0306-

0307], fig. 42). This teaches that after the user request telephone call, the telephone is

used for searching query. Therefore, it would have been obvious to a person having

ordinary skill in the art at the time of the invention was made to modify by incorporating

receiving a telephone call from a viewer via a telephone system, generating a search

query in response to the telephone call with the system of Kaizu. Thus, one having

ordinary skill in the art at the time the invention was made would have been motivated

to use such a modification because that would provide Junqua's system the enhanced

database searching method by direct telephone call request in the data retrieval

system.

Claim 2 is discussed in claim 1, identifying the viewer from which the telephone

call is received via caller ID by Kaizu page 17, section [0302].

Claim 3 is discussed in claim 1, search query is at least partially generated from

spoken language from the viewer which is received via the telephone system and input

into a voice recognition module by Kaizu page 17, sections [0300-0307].

With respect to claims 4-5, Junqua discloses current television programming

information and period of future television programming information are maintained in

the database, (54, program database, fig. 1, col. 3, lines 18-44, EPG is stored on

program database).

With respect to claim 6, Junqua discloses deactivating the search results after

the telephone call has terminated such that they are no longer displayable on the

television, (fig. 1, col. 3, lines 18-44, EPG is stored on program database).

With respect to claim 7, Junqua discloses announcing a summary of the search

results to the viewer via the telephone system, see (col. 4, lines 14-22).

With respect to claims 8-10, Junqua discloses the search results include a list of

channels showing programs which match the search query, wherein the viewer can

selectively scroll through the list of channels and the viewer can select a channel from

the list of channels to view information about the program being shown on that channel,

see (col. 4, lines 14-22).

With respect to claim 11, Junqua discloses, database in which television

programming information is maintained, see (54, program database, fig. 1, col. 3, lines

18-44, EPG is stored on program database), searching database in accordance with

the search query received, (col. 4, lines 14-22), generating search results which are

sent to a television receiver box of the viewer via the television system such that the

search results are displayable upon a television operatively connected to the television

receiver box, see (46, 50, fig. 1, results are displayed on TV screen, col. 3, lines 7-67

to col. 4, lines 1-55). Junqua does not explicitly disclose, generating a search query in

response to the telephone call received from a view a telephone call from a viewer via

a telephone system. However, Kaizu discloses, "In step S204, the main control unit 61

judges whether the user has made a voice input through the microphone 43. The step

is repeated until a voice input is judged to be made. [0301] If in step S204 the user is

judged to have made a voice input (e.g., pronouncing "registered user"), step S205 is

reached. In step S205, the main control unit 61 boots the voice recognition program

173 to recognize the voice entered in step S204. From step S205, control is returned

to step S202If in step S204 the user is judged to have made a voice input (e.g.,

pronouncing "registered user"), step S205 is reached. In step S205, the main control

unit 61 boots the voice recognition program 173 to recognize the voice entered in step

S204. From step S205, control is returned to step S202", see (page 17, sections

[0300-0301]), [0302] In step S202, the main control unit 61 receives another compact

HTML file from the EPG server 10 via the Internet 8, and displays a predetermined

screen (log-in screen of FIG. 16 in this case) reflecting the received file on the liquid

crystal display 35. At the same time, the sound corresponding to the content of the file

is fed to the speaker 34 for output. This causes the speaker 34 to output an audio

message, such as "Please pronounce your user ID and password", and "If in step S203

the user is judged to have requested transmission of the recording reservation data,

step S206 is reached. In step S206, the main control unit 61 disconnects from the

EPG server 10. [0307] Given the transmission request, the EPG server 10 searches

the EPG information database (not shown) for the recording reservation data needed

to reserve the desired TV program of a specific TV station, retrieves the applicable

recording reservation data", see (page 17, sections [0306-0307], fig. 42). This teaches

that after the user request telephone call, the telephone is used for searching query.

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time of the invention was made to modify by incorporating generating a search query in

response to the telephone call received from a view a telephone call from a viewer via

a telephone system with the system of Kaizu. Thus, one having ordinary skill in the art

at the time the invention was made would have been motivated to use such a

modification because that would provide Junqua's system the enhanced database searching method by direct telephone call request in the data retrieval system.

With respect to claim 12, Junqua discloses voice recognition module that receives spoken language from the viewer and converts it into at least a portion of the search query, see (32, speech recognition, fig. 1, col. 3, lines 31-67 to col. 4, lines 1-41).

With respect to claim 13, Junqua discloses current television programming information and period of future television programming information are maintained in the database, see (program database, fig. 1, col. 3, lines 18-44, EPG is stored on program database).

With respect to claim 14, Junqua discloses current television programming information and period of future television programming information are maintained in the database, see (54, program database, fig. 1, col. 3, lines 18-44, EPG is stored on program database).

With respect to claim 15, Junqua discloses the television system is selected from a group consisting of a digital cable television system, an analog cable television system, and a satellite television system, see (program database, fig. 1, col. 3, lines 18-44, EPG is stored on program database).

With respect to claim 16, Junqua discloses the television programming
information includes abstractions of program content, see (fig. 1, col. 3, lines 18-44,
EPG is stored on program database).

With respect to claim 17, Junqua discloses database includes a searchable field
containing identification of program types, see (fig. 1, col. 3, lines 18-44).

Claims 18-19 are discussed in claim 11, identifying the viewer from which the
telephone call is received via caller ID by Kaizu page 17, section [0302].

With respect to claim 20, Junqua discloses search results include a list of
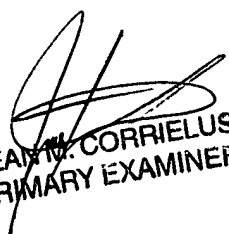channels showing programs which match the search query, see (col. 4, lines 14-22).

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
November 7, 2005

JEAN M. CORRIELUS
PRIMARY EXAMINER